

REMARKS

This Amendment Under 37 CFR 1.116 (Amendment) responds fully to the final Office Action mailed on September 25, 2007, in this application. In the Amendment, claims 1, 10, 11 and 18 have been amended, and claims 2-5, 14 and 15 have been cancelled without prejudice or disclaimer of subject matter. The subject matter of cancelled claims 2-5 is now included in amended independent claim 1. Claims 1, 6, 7, 10, 11, 16 and 18 are pending hereinafter, where claim 1 is the sole independent claim. Reconsideration of the final rejection of claims 1, 6, 7, 10, 11, 16 and 18 under 35 USC §103(a) in view of the amendment to independent claim 1, from which claims 6, 7, 10, 11, 16 and 18 depend, is respectfully requested.

Response To Rejections Under 35 USC §103(a)

Claims 1-7, 10, 11, 14, 16 and 18 were rejected under 35 USC §103(a) as unpatentable over US Patent No. 5,885,208, to Moriyama, in view of US Patent N. 4,690,175 to Ouchi, et al. (Ouchi). As mentioned, applicant has cancelled claims 2-5, 14 and 15, incorporating the subject matter of cancelled claims 2-5 into sole independent claim 1.

Claim 1

With respect to independent claim 1, the Examiner reiterates that Moriyama teaches the use of multiple sized endoscopes (7, 207, 307, 407), that each shares a video processor (4) and light source (3) (Moriyama at col. 19, lines 13-16). The Examiner further asserts that Moriyama teaches applicant's soft portion as claimed (13, 213, 313, 413) as part of insertion units (6, 206, 306, 406) of the endoscopes (col. 19, lines 25-29), which insertion units

have different diameters (col. 19, lines 40-41 and 45-47), that it would be inherent that the soft portions would have different diameters since they are part of the insertion units.

The Examiner further asserts that Ouchi teaches the use of flexible tubes for use with endoscopes to vary the flexibility of the endoscope tube, and more specifically teaches the use of a small diameter (A) and a large diameter (B) to vary the flexibility (Figs. 1 and 5, col. 7, lines 13-35), and that it would have been obvious to provide the Ouchi flexible tubing with Moriyama to provide an endoscope system of Moriyama to provide an endoscope with varying flexibility as taught by Ouchi.

Applicant respectfully disagrees, particularly in view of the instant amendment to independent claim 1. As amended, independent claim 1 sets forth an endoscope system, comprising:

- a first endoscope including an insertion unit having a soft section that comprises a small-diameter portion formed on the distal side of the soft section and a large-diameter portion which is formed on the operator side thereof opposite to the small-diameter portion and whose outer diameter is larger than the outer diameter of the small-diameter portion;

- a second endoscope that can share the same light source unit or video processor with the first endoscope and that has a soft section whose outer diameter is substantially the same over the whole length thereof;

- a third endoscope that can share the same light source unit or video processor with the first endoscope, and that has a soft section whose outer diameter is substantially the same over the whole length thereof and is substantially equal to or smaller than the outer diameter of the soft section of the second endoscope, wherein the outer diameter of the large diameter portion of the first endoscope is substantially equal to or smaller than the outer diameter of the

soft section of the second endoscope, and is substantially equal to or larger than the outer diameter of the soft section of the third endoscope.

Moriyama, as distinguished, discloses an endoscope system shown in Figs. 10 and 11, which figures and endoscope system are described in detail at col. 19, line 6, through col. 20, line 65. The Moriyama text states that endoscope 402 has a larger diameter than that of endoscope 302, but does not mention the size of the diameters of 313, 413. Put another way, there is no limitation found in Moriyama that reflects the limitations of applicants' claim 1. The claim 1 limitations include that the claimed system has three endoscopes, where each endoscope has a soft section, and that the diameters of the soft section of the first endoscope, are S and L, and $S \leq L$, that the diameters of the second and third endoscope soft sections do not change, and that the diameter of the third endoscope must always be less than or equal to the diameter of the second endoscope ($D_3 \leq D_2$).

Applicant's Specification, and amended independent claim 1, describe a relation $D_3 \leq L \leq D_2$, where D_2 and D_3 are the diameters of the second and third endoscopes, respectively. Amended independent claim 1 includes all of the limiting constituent features of cancelled claims 2-5, such that the relation $D_3 \leq L \leq D_2$ with respect to the large diameter of the first endoscope is articulated by the claim 1 language (with respect to second and third endoscopes D_2 and D_3).

Combining Moriyama with Ouchi still does not realize an endoscope system as set forth by amended independent claim 1. That is, while Ouchi teaches the use of flexible tubes having a small diameter (A) and a large diameter (B) to vary the flexibility (Figs. 1 and 5, col. 7, lines 13-35), the reference does not include or even suggest the limitations of amended independent claim 1. For that matter, only endoscope 1 of Ouchi includes a large diameter and a

small diameter. The relationship between the small-diameter portion and the large-diameter portion of Ouchi's endoscope is not defined anywhere in Ouchi, so is unclear, or indefinite.

It follows that neither Moriyama nor Ouchi describe a relation $D_3 \leq L \leq D_2$ with respect to the large diameter of the first endoscope and the second and third endoscopes (D_2 and D_3). Moreover, the invention of independent claim 1 includes the different endoscope diameter relationships as claimed not merely in order to provide desired flexibility as asserted by the Examiner in the outstanding final Office action, but to unite the diameters in order to eliminate a sense of uncomfortability. Independent claim 1 as amended obtains the effect stated at page 20, lines 1-12 of applicant's Specification that "because the outer diameter of the large diameter portion 10b (L) of the first endoscope 1A ranges from the largest outer diameter (2) of the soft sections 45 and 46 of the second and third endoscope 1B and 1C to the smallest outer diameter (3) thereof, an operator will hardly feel that something is uncomfortable when handling the first endoscope 1A.

Hence, in view of the amendment to independent claim 1, applicant respectfully asserts that claim 1 is patentable under 35 USC §103(a) over Moriyama in view of Ouchi, and requests withdrawal of the claim 1 rejection thereunder.

Claims 6, 7, 10, 11, 16 and 18

With respect to the rejection of claims 6, 7, 10, 11, 16 and 18 under Section 103(a), the Examiner asserts that Moriyama teaches multiple endoscopes with varying diameters, and a variety of flexibility, the Ouchi teaches using a flexible tubing to provide varying flexibility (Figs. 1, 2 and 5), and that it would have been obvious combine Moriyama and Ouchi.

In response, applicant respectfully asserts that claims 1, 6, 7, 10, 11, 16 and 18, are patentable for at least the reasons set forth (above) for the patentability of amended independent claim 1 under Section 103(a) over Moriyama in view of Ouchi, and request withdrawal of the rejection of claims 6, 7, 10, 11, 16 and 18, thereunder.

Conclusion

In concluding, applicant respectfully submits that, for the reasons discussed above, that each of pending claims 1, 6, 7, 10, 11, 16 and 18 patentably distinguish over the prior art, and are allowable. Applicant, therefore, requests that the Examiner reconsider and withdraw the final rejection and allow these claims.

If the Examiner believes that a telephone conference with applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'JFV', is written over the typed name 'John F. Vodopia'.

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